

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DR. WERNER GROH,
MICHAEL SCHOPS, DR. WILLI SEISS,
ROLF SCHWARZ, MONIKA NAGL,
WOLFGANG GREISER, MICHAEL ZEINER,
AND JURGEN UMMINGER

Appeal 2006-2883
Application 09/619,531
Technology Center 1700

Decided: August 17, 2007

Before CHUNG K. PAK, PETER F. KRATZ, and JEFFREY T. SMITH,
Administrative Patent Judges.

PAK, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's refusal to allow claims 1 through 11, 14, and 15. Claim 13 stands "objected as being dependent upon a rejected base claim, but would

be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." (Answer 2 and 8.) Claims 16 through 26, the only other claims pending in the above-identified application, stand withdrawn from consideration by the Examiner as being directed to a non-elected invention (Advisory Action dated Nov. 4, 2004 and Restriction Requirement dated April 10, 2002). We have jurisdiction pursuant to 35 U.S.C. § 6.

STATEMENT OF THE CASE

The subject matter on appeal is directed to a laminate of two or more layers useful for roofing and wall and floor coverings (Specification 1 and 2). Further details of the appealed subject matter are recited in representative claim 1 reproduced below:

1. A laminate of two or more layers, comprising:

at least one organic synthetic filament non-woven layer, and at least one woven web or scrim of glass fibers pre-consolidated by a binding agent,

said at least one synthetic non-woven and said at least one woven web or scrim are bound by needling such that a part of the organic synthetic filaments penetrate through the laminate and emerge at the lower surface of the laminate and lie adjacent thereto; and

wherein the formed laminate is subjected to a final consolidation by an acrylate or a styrene binder.

As evidence of unpatentability of the claimed subject matter, the Examiner has relied upon the following references:

Binnersley

US 4,816,327

Mar. 28, 1989

Hiers	US Re. 33,023	Aug. 15, 1989
Heidel	US 5,171,629	Dec. 15, 1992
Johnson	US 5,571,596	Nov. 5, 1996
Baravian	US 5,616,395	Apr. 1, 1997
Schops	US 6,235,657 B1	May 22, 2001

The Examiner has rejected the claims on appeal as follows:

- 1) Claims 1 and 3 through 11 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Baravian, Schops and Hiers;
- 2) Claim 2 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Baravian, Schops, Hiers and Heidel;
- 3) Claim 14 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Baravian, Schops, Hiers, and Binersley; and
- 4) Claim 15 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Baravian, Schops, Hiers, and Johnson.

The Appellants appeal from the Examiner's decision rejecting the claims on appeal under 35 U.S.C. § 103(a).

ISSUE

Has the Examiner demonstrated that Baravian and Schops would have directed one of ordinary skill in the art to the subject matter of claim 1 on appeal within the meaning of 35 U.S.C. § 103?¹

¹ As indicated *supra*, each and every § 103 rejection on this appeal includes Baravian and Schops. Therefore, the propriety of the Examiner's § 103 rejections hinges on the combinability of Baravian and Schops in the manner proposed by the Examiner.

FACTS, PRINCIPLES OF LAW, AND ANALYSES

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary consideration (e.g., unexpected results). *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 148 USPQ 459, 467(1966). “[A]nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-741, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-337 (Fed. Cir. 2006). The analysis supporting obviousness, however, should be made explicit and should “identify a reason that would have prompted a person of ordinary skill in the art to combine [known] elements” in the manner claimed. *KSR*, 127 S.Ct. at 1731, 82 USPQ2d at 1389.

Applying the above precedents to the present situation, we determine that the Examiner has not demonstrated that the prior art references relied upon would have directed a person of ordinary skill in the art to the claimed subject matter. As correctly pointed out by the Appellants (Br. 4), Baravian teaches at column 6, lines 46-52, that:

The consolidation and thermostabilization take place *only* in the first layer and before assembly with the second layer and all binder fibers being absent from the first layer, and hence all thermobinding being absent, the reinforcement according to the invention has *no significant shrinkage force*. [Emphasis added.]

Baravian also teaches away from employing a three-layer reinforcement, such as the one discussed in Schops (col. 2, ll. 10-16). Thus, from our perspective, one of ordinary skill in the art would not have looked to Schops' three-layer reinforcement to modify the two-layer reinforcement of the type discussed in Baravian. To further consolidate the two-layer reinforcement taught by Baravian with additional binding agents in the manner discussed in Schops would destroy the invention on which Baravian is based. *See Ex parte Hartmann*, 186 USPQ 366, 367 (Bd. App. 1974).

Accordingly, we concur with the Appellants that the Examiner has not demonstrated that the prior art relied upon would have rendered the appealed subject matter obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

ORDER

The decision of the Examiner is reversed.

REVERSED

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